REMARKS

Claims 1-27 are currently pending in the present application and are presently under consideration. All pending claims with status identifiers are at pages 2-9.

Applicants' representative acknowledges with appreciation the Examiner's indication that claims 4, 8-13, 15-20, and 24-27 would be allowable if recast in independent form to recite all limitations of respective base claims and any intervening claims. However, it is believed such amendments are not necessary in view of the deficiencies discussed *infra* of the cited art *vis a vis* applicant's claimed invention.

Favorable reconsideration is requested in view of the comments below.

I. Rejection of Claims 1-3, 5-7, 14, and 21-23 under 35 U.S.C. §103(a)

Claims 1-3, 5-7, 14, and 21-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tjandrasuwita, *et al.*(US Patent 5,422,654) in view of Hicok, *et al.* (US Patent 5,559,533). Reconsideration and allowance of claims 1-3, 5-7, 14, and 21-23 is respectfully requested for at least the following reasons. Neither Tjandrasuwita, *et al.*, nor Hicok, *et al.*, individually or in combination, teach or suggest all the claim limitations of the subject invention.

> In order to establish a prima facie case of obviousness, the teaching or ***suggestion*** to make the claim modification ***must be found in the cited art,*** not based on the applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, the mere fact that the reference can be modified does not render the modification obvious unless the cited art also suggests the desirability of the modification. *In re Mills,* 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Tjandrasuwita, *et al.* teaches a method of generating a dual scan display comprising a first display region adjacent to a second display region. The Examiner concedes that Tjandrasuwita, *et al.* does not teach or suggest a hardware cursor adapted to concurrently overlay a cursor on the first and second display regions, and accordingly cites Hicok, *et al,* which discloses a hardware cursor for a ***single scan display environment.*** However, the hardware cursor taught in Hicok, *et al.*, ***cannot operate effectively*** in a dual scan display environment.

Hicok, *et al.* discloses a hardware cursor in which an unused portion of Video Ram is utilized as cursor memory to store cursor information, wherein the hardware cursor is created in such a manner to minimize a number of gates and silicon required for implementation. The hardware cursor disclosed in Hicok, *et al.* monitors each pixel within a horizontal line during a scan, and effectively manipulates pixels overlayed by a cursor to display such cursor. Monitoring pixels continues until every horizontal line of pixels within a display region has been scanned, and the process is repeated thereafter.

Dual scan displays provide faster refresh rates than conventional single scan displays by dividing the display region into two segments that are refreshed at substantially the same time by utilizing separate data paths corresponding to each segment. Therefore, combining a dual-scan display with the hardware cursor disclosed in Hicok, *et al.* results in enabling display of a cursor on a pre-determined segment, as each segment standing alone operates as a single scan display. However, as Hicok, *et al.* teaches a hardware cursor utilized in conjunction with a single scan display, a cursor can only be displayed on a single segment in a dual scan environment, and furthermore could not be displayed concurrently on two segments. Thus, Hicok, *et al.* does not teach or suggest use of a hardware cursor in a dual scan environment.

In contrast, the claimed invention allows use of a hardware cursor in a dual scan display environment, thereby eliminating software overhead associated with conventional cursor display techniques in such a display environment. In the Final Office Action dated May 2, 2003, the Examiner has simply restated that *via* combining Tjandrasuwita, *et al.* and Hicok, *et al.*, all elements of the subject claimed invention are obtained. However, proof that the separate elements exist in the prior art is inadequate to establish obviousness. *See Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). Furthermore, motivation to combine the two cited references does not exist within either reference. The Federal Circuit requires the Examiner to show a motivation to combine the references to create the case of obviousness. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (*citations omitted*).

The Examiner thus has extracted benefits disclosed in the specification of the subject invention to overcome problems associated with conventional methods (*e.g.*, utilizing a hardware cursor in conjunction with a ***dual scan display*** to eliminate software

overhead). Applicant respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103, as one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (citations omitted).

In view of the foregoing, it is respectfully submitted that the rejection of independent claims 1, 5, 21, and dependent claims 2, 3, 6, 7, 14, 22, and 23, which respectively depend therefrom, be withdrawn.

II. Conclusion

The present application is believed to be condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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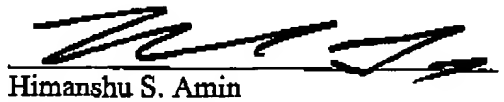

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